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09/594,408	06/15/2000	Joey L. Erickson	33012/292/101	9110

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Charles A Johnson
Unisys Corporation
Law Department M S 4773
2470 Highcrest Road
Rosenville, MN 55113

EXAMINER

COLLINS, SCOTT M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/30/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No.	Applicant(s)	
	09/594,408	ERICKSON ET AL.	
	Examiner	Art Unit	
	Scott M. Collins	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 examined.
2. All claim objections have been withdrawn in light of applicant's amendments.
3. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment A on 11/3/2003.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 5, 10, 15, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of these claims claim a particular software package or computer without claiming the specific version number or type of computer.
6. Claim 4 contain the trademark/trade name NT Server. Claims 10 and 20 contain the trademark/trade name Windows. Claim 15 contains the trademark/trade name Visual Basic. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

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trademark/trade names are used to identify/describe software packages and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 6-8, and 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gebauer, U.S. Patent Number 6,370,588 B2 (herein Gebauer).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

9. Referring to claim 1, Gebauer has taught a data processing system having a user terminal for entering a transaction request, wherein said transaction request has one of a plurality of formats, responsively coupled via a publicly available digital communication network to an enterprise server for responding to said transaction request (Gebauer figure 4, requesting client 64, network 84, and enterprise server 86; and figures 5 and 6 show that the one format of a

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plurality of possible formats is HTML.), the improvement comprising a generic gateway interposed between said user terminal and said enterprise server which responsively couples said user terminal to said enterprise server (Gebauer figures 3-6, 9, 12 all pertain to a generic gateway interposed between the user and the server.).

10. Referring to claim 2, Gebauer has taught the improvement further comprising a plurality of adapters interposed between said generic gateway and said user terminal which responsively couples said user terminal to said generic gateway wherein each one of said plurality of adapters corresponds to said one of said plurality of formats (Gebauer figure 4 and column 8, lines 4-36 where the client's request is adapted to use each service 70 and 72. Also, Gebauer figure 8 and column 12, lines 20-42 show the user's request being adapted based on the type of service.).

11. Referring to claim 3, Gebauer has taught the improvement wherein said publicly available digital communication network further comprises the internet (Gebauer figure 9 and column 8, lines 7-12).

12. Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

13. Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the rejection of claims 1 and 2 above.

14. Referring to claims 12 and 17, Gebauer has taught the method further comprising transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Gebauer figure 4 and column 8, lines 4-36 where the clients request is adapted to use each service 70 and 72. Also, Gebauer figure 8 and column 12, lines

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20-42 show the user's request being adapted based on the type of service. In both cases, once the request has been adapted (which is synonymous with the act of converting or processing) it is directed to the actual service provider via the connection between them.).

15. Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

16. Referring to claim 14, Gebauer has taught the method wherein said one of said plurality of formats further comprises an active server page (Gebauer figure 4, elements 70 and 72).

17. Referring to claim 15, Gebauer has taught the method wherein said one of said plurality of formats further comprises visual basic (Gebauer column 8, lines 24-27).

18. Referring to claim 18, Gebauer has taught an apparatus wherein said one of said plurality of adapters corresponds to said one of said plurality of connectors (Gebauer figure 4 where each adapter corresponds to the connector whereby the adapter is connected to the client.).

19. Claims 1-3, 6-8, 11-13, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ronen, U.S. Patent Number 5,845,267 (herein referred to as Ronen).

20. Referring to claim 1, Ronen has taught a data processing system having a user terminal for entering a transaction request, wherein said transaction request has one of a plurality of formats, responsively coupled via a publicly available digital communication network to an enterprise server for responding to said transaction request, the improvement comprising a generic gateway interposed between said user terminal and said enterprise server which responsively couples said user terminal to said enterprise server (Ronen figure 1 and column 5,

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line 43 – column 6, line 9 where transaction server 121 acts as a gateway between user terminal 101 and server 126.).

21. Referring to claim 2, Ronen has taught the improvement further comprising a plurality of adapters interposed between said generic gateway and said user terminal which responsively couples said user terminal to said generic gateway wherein each one of said plurality of adapters corresponds to said one of said plurality of formats (Ronen figure 1 and column 5, line 43 – column 6, line 9 where the adapters are that which adapt the request to be processed by the server.).

22. Referring to claim 3, Ronen has taught the improvement wherein said publicly available digital communication network further comprises the internet (Ronen figure 1 element 104).

23. Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

24. Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the rejection of claims 1 and 2 above.

25. Referring to claims 12 and 17, Ronen has taught the method further comprising transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Ronen figure 1 and column 5, line 43 – column 6, line 9 where the request is passed to the billing server (column 6, lines 10-13)).

26. Referring to claim 18, Ronen has taught an apparatus wherein said one of said plurality of adapters corresponds to said one of said plurality of connectors (Ronen figure 1 and column 5,

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line 43 – column 6, line 13 where each adapter is located within the transaction server 121 and corresponds to the connector between the transaction server and the billing server).

27. Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

28. Claims 1-13, 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Deisinger et al., U.S. Patent Number 6,397,220 B1 (herein Deisinger).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

29. Referring to claim 1, Deisinger has taught a data processing system having a user terminal for entering a transaction request (Deisinger figure 1, client 36), wherein said transaction request has one of a plurality of formats (Deisinger figure 3, elements 236, 240, 244, 248, 252, 256, 260, 264), responsively coupled via a publicly available digital communication network to an enterprise server for responding to said transaction request (Deisinger figure 1, enterprise server 52), the improvement comprising a generic gateway interposed between said user terminal and said enterprise server which responsively couples said user terminal to said enterprise server (Deisinger figure 1, gateway 40).

30. Referring to claim 2, Deisinger has taught the improvement further comprising a plurality of adapters interposed between said generic gateway and said user terminal which responsively couples said user terminal to said generic gateway wherein each one of said plurality of adapters corresponds to said one of said plurality of formats (Deisinger figure 2, element 229 where the user's request is adapted based on the type of service.).

31. Referring to claim 3, Deisinger has taught the improvement wherein said publicly available digital communication network further comprises the internet (Deisinger column 4, lines 42-43).

32. Referring to claims 4 and 9, Deisinger has taught the improvement further comprising an NT Server housing said generic gateway and providing a middleware environment (Deisinger figures 3 and 4 and column 6, lines 26-32).

33. Referring to claims 5, 10, and 20, Deisinger has taught the improvement wherein said user terminal further comprises an industry compatible personal computer operating under Windows (Deisinger column 4, lines 40-46 where Windows is the operating system for over 90% of "industry compatible personal computers.).

34. Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

35. Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the rejection of claims 1 and 2 above.

36. Referring to claims 12 and 17, Deisinger has taught the method further comprising transferring said converted and processed service request from said generic gateway to an end

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service provider via a connector (Deisinger figure 2 and column 5, lines 27-51 where the middleware adapts / converts / processes the requests and routes the it to the correct service provider via connections 225, 227, etc.).

37. Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

38. Referring to claim 18, Deisinger has taught an apparatus wherein said one of said plurality of adapters corresponds to said one of said plurality of connectors (Deisinger figure 2 where the adapters in element 229 correspond to the connector (225, 227, etc.) that will route to the service provider.).

Response to Arguments

39. Applicant's arguments filed 11/03/2003 have been fully considered but they are not persuasive. The examiner has added limited information to the rejection in order to respond to portions of applicant's arguments by further clarifying the rejection.

40. Regarding the rejections of claims 6-8, 11, 13, 16, 19, applicant alleges that the common practice of rejecting logically equivalent sets of claims by pointing to the same citation for a different type of invention whose limitations are identical in scope to the first set of claims is an unlawful and factually erroneous practice. If it would assist applicant, the examiner will explicitly point to the same citations in the references for each of the claims 6-8, 11, 13, 16, 19, but the examiner does not see the purpose in this. The fundamental issue lies in the difference between an apparatus and a method (or other types of inventions). For anyone who is well versed in the computer and computer networking arts, it is easy to understand that while a computer is a physical apparatus, it is also always performing a method by any action it does (even down to the most basic act of computation).

41. Another fundamental issue is applicant's term "generic gateway" in the independent claims. While applicant defines this term in the specification, the claims stand on their own merit and the specification is not read into the claims (with the exception of 'means plus function' type claims as applicant discusses). It would be highly advantageous for applicant to further qualify how a "generic gateway" differs from any standard gateway in the art since the term "generic gateway" is not common in the art. Further, on page 21, lines 4-5, applicant argues that "Applicants' [generic gateway], on the other hand, accommodate[s] these differing

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formats through the use of a single generic gateway.” However, this feature (which appears to define the invention) is not found in the independent claim being discussed.

Conclusion

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Starkovich et al. U.S. Patent Number 6,212,546

Robins et al. U.S. Patent Number 6,115,744

Subramaniam et al. U.S. Patent Number 5,859,972

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 703.305.7865. The examiner can normally be reached on Mon.-Fri. 8:00 am - 5:30 pm with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703.308.5221. The fax phone number for the organization where this application or proceeding is assigned is 703.746.7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

smc
January 23, 2004


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100